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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/687,033 | 10/12/2000 | Howard J. Glaser | STL920000062US1 | 8030 |

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| EXAMINER | |
|---|---|
| GROSS, KENNETH A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2122 | 5 |

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/687,033 | GLASER ET AL. | |
| | Examiner | Art Unit | |
| | Kenneth A Gross | 2122 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 2 of copending Application No. 09/687,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1 and 2 of the copending application No. 09/687,412 correspond directly with Claim 1 of the current application. The current application teaches installing an application program whereas the copending application No. 09/687,412 teaches updating an application program. However, since both applications build an application program for execution on a data processing system, the copending application No. 09/687,412 must install the updated program on the data processing system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

3. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 4 of copending Application No. 09/687,414. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1, 2, and 4 of the copending application No. 09/687,414 correspond directly with Claim 1 of the current application. Although the current application teaches installing an application program whereas the copending application No. 09/687,414 teaches simply downloading an application program, Claim 2 of the current application does teach downloading data to the data processing system which is used in building the application program.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4-6, 11-13, and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4, 11, and 18 recite the limitation "which items" There is insufficient antecedent basis for this limitation in the claim. Claims 6, 13, and 20 recite the limitation "remote server" There is insufficient antecedent basis for this limitation in the claim. Claims 5, 12, and 19 are rejected for being dependent on rejected parent claims.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 4, 8, 11, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner (U.S. Patent Number 6,314,565) in view of Hsu (U.S. Patent Number 5,894,515).

In regard to Claim 1, Kenner teaches: (a) defining a configuration of the application program corresponding to a particular user of the application program (Column 7, lines 5-12); (b) determining whether the configuration corresponds to the user. Since the information is pulled from the user's computer registry, it must correspond with the requesting user; and (c) building the application program according to a user configuration (Column 8, lines 30-41). Kenner does not teach encrypting the configuration, authorizing a user in response to a user request for the application program, and decrypting the manifest file to produce a decrypted configuration. Hsu, however, does teach encrypting data, authorizing a user, and in response to authorizing a user, decrypting the data (Column 1, lines 13-21). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform a method for installing software with a configuration file as taught by Kenner, where the configuration file is encrypted and decrypted only in response to a user authentication, as taught by Hsu, since computer configuration information may contain sensitive data, and encryption allows only authorized users to access the data. Claims 8 and 15 correspond directly with Claim 1, and are rejected for the same reasons as Claim 1.

In regard to Claim 4, Kenner and Hsu teach the article of manufacture of Claim 1, and Kenner further teaches discovering which items are being used by a user (Column 7, lines 5-8). Kenner does not explicitly teach recording this information, however, it would be obvious to record this information, since it needs to be transmitted from the local to the remote machine, and hence would need to be recorded in a file or a request before being sent. Claims 11 and 18 correspond directly with Claim 4, and are rejected for the same reasons as Claim 4.

6. Claims 2, 3, 6, 7, 9, 10, 13, 14, 16, 17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner (U.S. Patent Number 6,314,565) in view of Hsu (U.S. Patent Number 5,894,515) and further in view of Hayes, Jr. (U.S. Patent Number 6,205,476).

In regard to Claim 2, Kenner and Hsu teach the article of manufacture of Claim 1, and Kenner further teaches initiating a connection between the local and remote data processing systems in response to a user request (Column 9, lines 39-53) and downloading data from the remote to the local data processing system according to a stored configuration (Column 8, lines 18-29). Neither Kenner nor Hsu teach storing the configuration on a remote server and downloading the manifest file from the remote to the local data processing system. Hayes, however, does teach storing user-specific application configuration preferences, and transmitting the preferences to the local user system (Column 22, lines 55-59). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform a method for installing software with a configuration file by initiating a session between the local and remote data processing system and downloading the data from the remote data processing system as taught by Kenner, where the configuration file is encrypted and decrypted only in response to a user authentication, as taught by Hsu, where the configuration file is stored on the remote system

and transferred to the local system as taught by Hayes, since this allows for a more organized and more central repository of user application preferences. Claims 9 and 16 correspond directly with Claim 2, and are rejected for the same reasons as Claim 2.

In regard to Claim 3, Hsu teaches decrypting data (Column 1, lines 13-21) and Kenner teaches building the application program according to a user configuration (Column 8, lines 30-41). Hsu does not explicitly teach authenticating a user in response to a request for application build, however, since the information is encrypted, in order to build the application, it must be decrypted by a decryption process on the local computer system. Thus, this decryption acts as an authentication process, since only an authorized user knows the decryption process. Claims 10 and 17 correspond directly with Claim 3, and are rejected for the same reasons as Claim 3.

In regard to Claim 6, Hayes teaches that the remote processing system comprises a web server for transferring user profile data to the client (Figure 2, item 218). Claims 13 and 20 correspond directly with Claim 6, and are rejected for the same reasons as Claim 6.

In regard to Claim 7, Hayes teaches storing application program configurations and user permissions (Column 1, lines 58-63). Hayes further teaches storing user data (Figure 15). Claims 14 and 21 correspond directly with Claim 7, and are rejected for the same reasons as Claim 7.

7. Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner (U.S. Patent Number 6,314,565) in view of Hsu (U.S. Patent Number 5,894,515) and further in view of Misra et al. (U.S. Patent Number 6,189,146).

In regard to Claim 5, Kenner and Hsu teach the article of manufacture of Claim 4 but do not teach recording a description of items being used by a user for administering licenses. Misra, however, does teach storing a list of software that the user has for the purposes of administering

licenses (Column 9, lines 29-36). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to construct the article of manufacture of Claim 1, as taught by Kenner and Hsu, where the article of manufacture further stores a list of software that the user has for the purposes of administering licenses (Column 9, lines 29-36), since this allows a more organized way of keeping track of computer software licenses administered to clients, and prevents software piracy. Claims 12 and 19 correspond directly with Claim 5, and are rejected for the same reasons as Claim 5.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Hendrickson et al (U.S. Patent Number 5,933,646) teaches storing a user personality file (Column 9, lines 38-50).

Win et al. (U.S. Patent Number 6,161,139) teaches user authentication and a registry server with encrypted information.

Kroening et al. (U.S. Patent Number 6,080,207)

Manduley (U.S. Patent Number 5,956,505)

Walden, Jr. et al. (U.S. Patent Number 6,052,531)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

KAG
May 16, 2003

KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100